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10/086,661

02/28/2002

Elliot Brenhouse

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EXAMINER

O'CONNOR, GERALD J

ART UNIT

PAPER NUMBER

3627

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/086,661

Applicant(s)

Brenhouse

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 20, 2006 (Amdt) and May 22, 2006 (Dwgs).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 22, 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on March 20, 2006 and to the drawings filed by applicant on May 22, 2006, both in reply to the previous Office action on the merits, mailed September 14, 2005.
2. The amendment of claims 1, 16, and 17 by applicant in the reply filed March 20, 2006 is hereby acknowledged.

Election/Restriction

3. The previous Office action on the merits, mailed September 14, 2005, considered applicant's arguments regarding the restriction requirement, and the restriction requirement was still deemed proper and was therefore made FINAL¹ (see § 4 of the Office action mailed September 14, 2005). Further/continued/additional arguments regarding the requirement for restriction are now considered to be unseasonable, in view of compact prosecution.
4. This application contains claims 17-28 drawn to an invention nonelected with traverse. A complete reply to the final rejection *must* include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

¹ Not to be changed or reconsidered; unalterable (*The American Heritage Dictionary of the English Language, Third Edition*).

Drawings

5. The corrected or substitute drawings received on May 22, 2006 are hereby approved.

Claim Rejections - 35 USC § 112, Second Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “normally” in claims 1 and 16 (line 2 of each claim) is a relative term which renders the claim indefinite. The term “normally” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claims 1-4 and 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mason (US 6,497,361).

Mason discloses a customer self-checkout system for processing article purchases of articles normally having a security tag attached thereto, the system comprising: a self-checkout station comprising: an input device configured to receive product code input designating an article for purchase; a deactivation device configured to produce a deactivation region effecting deactivation of a security tag attached to an article for purchase; and a prompting system configured to present a deactivation prompt to direct a user to position an article for purchase within the deactivation region to effect security tag deactivation.

Regarding claim 2, in the system of Mason the prompting system is configured to present a second prompt directing a user to enter a product code using the input device.

Regarding claim 3, the system of Mason further comprises: a target visibly disposed proximate the deactivation region at the checkout station; and wherein the second prompt instructs the user to move the article to touch the target to effect security tag deactivation.

Regarding claim 4, in the system of Mason the prompting system is configured to present the deactivation prompt after a receipt of a product code by the input device.

Regarding claim 7, the system of Mason further comprises a sensor for sensing the presence of an article within the deactivation region.

Regarding claim 8, the system of Mason further comprises: a bagging platform comprising a scale operatively coupled to the prompting system and configured to detect weight of bagged articles; and wherein the prompting system is configured to present the deactivation prompt when a weight change is detected by the bagging scale and the sensor has not sensed presence of the article within the deactivation region.

Regarding claim 9, in the system of Mason the prompting system is configured to present a prompt providing instructions to a user to place the article into a bag on the bagging platform.

Regarding claim 10, in the system of Mason the bagging platform further comprises a bag holder adapted to hold a bag for receiving articles.

Regarding claim 11, in the system of Mason the prompting system is configured to present a feedback prompt to confirm deactivation of the security tag after the sensor senses presence of an article within the deactivation region.

Regarding claim 12, in the system of Mason the feedback prompt comprises a prompt instructing the user to place the article in a bag.

Regarding claim 13, in the system of Mason the input device comprises a device selected from the group consisting of a bar code scanner, a scanner-scale module, a touch-screen display, and a keypad.

Regarding claims 14 and 15, in the system of Mason the prompt comprises an animated/audio prompt provided by an audio device.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5, 6, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason (US 6,497,361).

Mason discloses a customer self-checkout system for processing article purchases of articles normally having a security tag attached thereto, as applied above in the rejection of claims 1 and 4 under 35 U.S.C. 102(b), but Mason fails to disclose that the database system coupled to the self-checkout station and comprising stored data identifying articles having attached security tags also stores data on articles not having attached security tags to determine whether an article designated by the received product code input has an attached security tag; and wherein the prompting system is configured to present the deactivation prompt when the article has an attached security tag and to not present the deactivation prompt when the article does not have an attached security tag, the system of Mason presenting the deactivation prompt

when the stored data associated with an article does not indicate whether said article has an attached security tag or not, since the system of Mason seems to assume that all items in the store would have a security tag needing to be deactivated.

However, it is well known to those of ordinary skill in the art, that, ordinarily, due to the cost of the security tags, not all items in a store are provided with security tags, and it would be self-evident/inherent that items not having security tags would not need to have a security tag deactivated.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Mason so as to use store in the database of item weights, an indication as to whether or not each item is protected by a security tag, and to only deactivate tags for items that have such tags, as is well known to do, in order to accommodate stores having a mix of inventory partially protected by security tags and partially not protected by security tags, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

12. Applicant's arguments filed March 20, 2006 have been fully considered but they are not deemed persuasive.

13. Regarding the arguments concerning the requirement (not "request") for restriction, the requirement was reconsidered and made "final" in the last Office action on the merits, mailed

September 14, 2005 (§ 4). Further/continued/additional arguments regarding the requirement for restriction are now considered to be unseasonable, in view of compact prosecution

14. Regarding the argument that the previous Office action was a final rejection, the previous Office action was not a final rejection, thus, the argument has been disregarded.

15. Regarding the arguments pertaining to applicant's amendment to the language of the preambles of the claims, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

16. Regarding the argument that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

17. Regarding the arguments concerning applicant's intended use of the claimed apparatus, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to the disclosure.

19. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

20. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at: <http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at: <http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

January 30, 2007

 1/30/07

Gerald J. O'Connor

Primary Examiner

Group Art Unit 3627